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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,581	07/15/2003	Gerard Manning	038602-1613	6890
22428	7590	09/14/2005	EXAMINER	
FOLEY AND LARDNER SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			SWOPE, SHERIDAN	
			ART UNIT	PAPER NUMBER
			1656	

DATE MAILED: 09/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/618,581

Applicant(s)

MANNING ET AL.

Examiner

Sheridan L. Swope

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-26 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

### DETAILED ACTION

Claims 1-26 are pending.

#### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-9, drawn to a method for identifying an agent that inhibits the activity of a kinase polypeptide, classified in class 435, subclass 15.
- II. Claims 26, in part, and 10-13, drawn to a cellular method for identifying an agent that has anti-fungal activity, classified in class 435, subclass 7.31.
- III. Claims 14-23, drawn to a method of treating a subject having a fungal infection by administering an inhibitor of a fungal kinase polypeptide, classified in class 514, subclass 1.
- IV. Claims 24 and 25, drawn to a composition comprising an inhibitor of a fungal kinase polypeptide, classified in class 435, subclass 15.
- V. Claim 26, in part, drawn to an in vitro method for identifying an agent that has anti-fungal activity, classified in class 435, subclass 7.31.

For each of Inventions I-V above, restriction to one of the following is also required under 35 USC 121 and 327. Therefore, election is required of one of Inventions I-V and one or more of Inventions (A)-(H), as indicated.

For any of Inventions I-V, elect one of:

(A.) KIN1 kinase

Elect one of SEQ ID NO: 1-5

(B.) KIN4 kinase

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Elect one of SEQ ID NO: 6-9

(C.) GIN4 kinase

Elect one of SEQ ID NO: 10-16

(D.) RAN kinase

Elect one of SEQ ID NO: 17-24

(E.) ELM kinase

Elect one of SEQ ID NO: 25-29

(F.) HAL kinase

Elect one of SEQ ID NO: 30-42

If Invention II is elected, also elect one of:

(G.) Chitin content assay

(H.) Agar dilution assay

Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). Also, product and process inventions are distinct if any of the following can be shown: (1) that the process as claimed can be used to make another and materially different product, (2) that the product claimed can be used in a materially different process of using that product, or (3) that the product claimed can be made by another and materially different process (MPEP § 806.05(h)). These inventions are different or distinct for the following reasons.

Inventions I-III and V are independent because the methods of Inventions I-III and V comprise different steps, utilize different products and/or produce different results.

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Inventions I, II, and V are unrelated to Invention IV because the methods of Inventions I, II, and V can neither use the product of Invention IV nor be used to make said product.

The method of Invention III is related to the inhibitor of Invention IV as a product and process of using. The inventions are distinct because the inhibitor can also be used for purification of the kinase.

A search for more than one of Inventions I-V would be a burden on the Office for the following reasons.

Because the methods of Inventions I-III and V comprise different steps, utilize different products, and/or produce different results, a search for one said invention would not encompass a search for any other invention and searching all of Inventions I-III and V, or a subset thereof would be a burden on the Office.

Because the methods of Inventions I, II, and V neither make nor use the product of Invention IV, a search for Invention IV would not overlap the searches for Inventions I, II, and V, and vice versa. Thus, a search of Invention IV with any of Inventions I, II, and V would be a burden on the Office.

A search for the product of Invention IV would not encompass a search for the method of Invention III, or vice versa, because said method is not the only method of making and/or using said product. Thus, a search of Invention IV with Invention III would be a burden on the Office.

These inventions are distinct for the reasons given above and have acquired a separate status in the art due to their recognized divergent subject matter, as shown by their different classification. Furthermore, as explained above, searching more than one invention would be a burden on the Office. Therefore, restriction for examination purposes, as indicated, is proper.

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Restriction between product and process claims has been required. Where Applicant elects claims directed to a product, and the product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the Official Gazette notice dated March 26, 1996 (1184 O.G. 86; see also M.P.E.P. 821.04, *In re Ochiai*, and *In re Brouwer*). Process claims that depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right, if the amendment is presented prior to final rejection or allowance, whichever is earlier. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. To be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheridan L. Swope whose telephone number is 571-272-0943. The examiner can normally be reached on M-F; 9:30-7 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathleen Kerr can be reached on 571-272-0931. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published application may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on the access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sheridan Lee Swope, Ph.D.

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A handwritten signature in black ink, appearing to read 'Swope', with a stylized flourish at the end.

**SHERIDAN SWOPE, Ph.D.**  
**PATENT EXAMINER**